



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,060	06/13/2000	Tatsuya Eguchi	52178-020	5731
20277 7590 08/15/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
HAN, QI				
ART UNIT		PAPER NUMBER		
2626				
MAIL DATE		DELIVERY MODE		
08/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/593,060

Applicant(s)

EGUCHI ET AL.

Examiner

QI HAN

Art Unit

2626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Amendment

2. This communication is responsive to the applicant's amendment dated 05/21/2008. The applicant(s) amended claims 1, 6 and 17 (see the amendment: pages 2-7).

The examiner withdrew the drawing objection regarding the previous amended claim elements, because the applicant amended the corresponding claims.

The examiner withdrew the claim rejection under 35 USC 112 1st and 2nd, because the applicant amended the corresponding claims.

Response to Arguments

3. Applicant's arguments filed on 05/21/2008 with respect to the claim rejection under 35 USC 102 and/or 103, have been fully considered but are moot in view of the new ground(s) of rejection, since the amended claims introduce new issue, which change the scope of the claims.

It is noted that the previous cited references are still applicable to the newly amended claims for the prior art rejection.

In response to the applicant's arguments regarding rejection claims 1 6, 11, 14 and 17 that "Yamauchi fails to disclose the outputting of a group of printed documents consisting of the original document and the translated document data in each of a plurality of languages, each as separate documents", "Flores discloses only one document containing translated materials",

“Flores fails to teach or suggest a translating device with each of the printed documents being distinct from one another, or separation or separate grouping of the translated documents from the original documents to make them distinct” (Remarks: page 10, last paragraph to page 11 paragraph 2), it is noted that the arguments against the references individually are not proper, because one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to the applicant's arguments regarding rejection claim 1, 6, 11, 14 and 17) that “the combination of Yamauchi and Flores fails to disclose the limitation” as claimed (Remarks: page 11, last paragraph to page 12, paragraph 1), the examiner respectfully disagrees with applicant's arguments and has a different view of the prior art teachings and the claim interpretations.

It is noted that Yamauchi teaches a multi-language translation system (col. 11, lines 37-45) that can output the documents in a first (original) language and a second (translated) language with different modes (corresponding to groups) (col. 41, lines 37-60) via a printer, plotter and/or personal computer (col. 1, lines 44-45; col. 7, lines 51-54). Yamauchi does not explicitly teach modes (groups) in that the document data comprise “a printed document in the original language and printed documents of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another”, i.e. outputting printed documents in one or more additional translated language(s). However, the feature of outputting group(s) having documents in respective (distinct) multiple translated languages is well known in the art as evidenced by Flores who discloses apparatus and methods

for multilingual user access (title), comprising that 'the database stores translation of documents in multiple languages and a variety of formats' in 'a computer system', 'user can choose to have the multiple translations' and 'to have a work displayed (output) in a written text in two or more separate languages' (Figs. 2-4 and col. 3, line 64 to col. 4, line 54, and col. 5, lines 27-57), showing the database storing separate translated files or tables (i.e. documents) (Fig. 4), and viewing and choosing two or more languages presented adjacently on display (col. 6, lines 47-54 and Figs. 5A-5B). Based on the teachings of Yamauchi's multi-language translation system that can output printable documents in the original language and one translated language, and teachings of Flores' computer and database based multi-language translation system that can generate and output (display) documents in multiple translated languages, as state above, one of ordinary skill in the art would have recognized that providing capability of outputting printable documents in multiple translated languages with different combination groups would be easily implemented by combining these teachings in the computer-database based multi-language translation system with printer and/or plotter, so that the combined system could operate the functionality for grouping, sorting, and printing the stored/generated multiple language documents in the same or similarly way as they are used before, and the operation result would be predicable, to the ordinary skilled person. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamauchi and Flores by providing computer-database based translation system translating and outputting (displaying or printing) document data in multiple languages (including multiple translated languages) with different combination groups (such as content groups, language groups, or common groups), for

the purpose (motivation) of being beneficial to users presenting a written (printed) text and its multiple translations in two or more separate languages (Flores: col. 4, lines 5-8).

Regarding dependent claims, the response to the applicant's argument is based on the same reason for the independent claims, as stated above, because the argument is based on the same issue as independent claims (see above).

For above reasons, the applicant's arguments are not persuasive, and the rejection is maintained.

Claim Rejections - 35 USC § 103

4. Claims 1, 4-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al. (5,701,497) hereinafter referenced as Yamauchi, in view of Flores et al. (6,370,498 B1) hereinafter referenced as Flores.

As per **claim 1**, Yamauchi teaches a translating apparatus comprising:

"translating means for translating document data of a document into another language" (Fig.1 and col. 7, lines 41-54, 'translation unit 9');

"an output unit for outputting the translated document data translated by said translating means in printed form" (col. 4, line 36 to col. 5, line 11, 'output means for outputting said received document (including translated document data in printed form); Fig. 1, 'bitmap exp 10' and 'plotter 11', 'PC/WS 12'; col. 7, lines 54-55, 'the translating unit 9 supplies the output text data...for transfer to the personal computer 12');

“a mode setting unit for setting the translating apparatus in a first mode or a second mode” (col. 4, lines 36-60, ‘wherein one of said first and second output means is selectively activated (mode setting)’);

“a controller”, (col.,7, lines 55-56, ‘the system of Fig. 1 includes a system controller’, which necessarily controls each unit, such as ‘OCR’, ‘translation’ and ‘outputs text data representing the result of translation’);

“wherein, in a case where the first mode is set, said controller controls said translating means so as to translate the document data into a plurality of languages, and controls said output unit so as to output the translated document data by language groups of printed documents, the language of each language group of printed documents consisting of one of the plurality of languages”, (col. 4, lines 39-45, ‘translating a received document, written in a first language, to a second, different language...output...in said second language... wherein one of said first and second output means is selectively activated (setting mode)’; col.,7, line 48, ‘outputs text data representing the result of translation’ (necessarily including printed document); col. 11, lines 40-45, ‘translating English to Japanese’ and/or ‘English to French...’; Fig. 24, showing different pages (interpreted as printed documents) in different language groups); and

“wherein, in a case where the second mode is set, said controller controls said translating means so as to translate the document data into a plurality of languages, and controls said output unit so as to output the document data by groups” (col. 4, lines 39-45; col. 7, line 48; col. 11, lines 40-45 and Fig. 24, same as stated above).

Yamauchi does not explicitly teach in the second mode, “each group of the document data comprising a printed document in the original language and printed documents of the

translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another.” However, the feature of outputting group(s) having documents in respective (distinct) multiple translated languages is well known in the art as evidenced by Flores who discloses apparatus and methods for multilingual user access (title), comprising that ‘the database stores translation of documents in multiple languages and a variety of formats’ in ‘a computer system’, ‘user can choose to have the multiple translations’ and ‘to have a work displayed (output) in a written text in two or more separate languages’ (Figs. 2-4 and col. 3, line 64 to col. 4, line 54, and col. 5, lines 27-57), showing the database storing separate translated files or tables (i.e. documents) (Fig. 4), and viewing and choosing two or more languages presented adjacently on display (col. 6, lines 47-54 and Figs. 5A-5B). Based on the teachings of Yamauchi’s multi-language translation system that can output printable documents in the original language and one translated language, and teachings of Flores’ computer and database based multi-language translation system that can generate and output (display) documents in multiple translated languages, as state above, one of ordinary skill in the art would have recognized that providing capability of outputting printable documents in multiple translated languages with different combination groups would be easily implemented by combining these teachings in the computer-database based multi-language translation system with printer and/or plotter, so that the combined system could operate the functionality for grouping, sorting, and printing the stored/generated multiple language documents in the same or similarly way as they are used before, and the operation result would be predicable, to the ordinary skilled person. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamauchi and Flores by providing computer-

database based translation system translating and outputting (displaying or printing) document data in multiple languages (including multiple translated languages) with different combination groups (such as content groups, language groups, or common groups), for the purpose (motivation) of being beneficial to users presenting a written (printed) text and its multiple translations in two or more separate languages (Flores: col. 4, lines 5-8).

As per **claim 4** (depending on claim 1), Yamauchi in view of Flores further teaches “said output unit includes a display for displaying the translated document data” (Yamauchi: Figs. 2 and col. 8, lines 33-34, ‘display unit 33’).

As per **claim 5** (depending on claim 1), Yamauchi in view of Flores further teaches “an operation unit for specifying a plurality of original languages and at least one language to be translated” (Yamauchi: Figs. 2 col. 7, lines 62, ‘system controller’, ‘input device 32 used by an operator’; col. 11, lines 40-45, ‘the translation unit achieves translation between other combination of languages...’; Fujita: col. 4, lines 4-8, ‘user can choose (specify) to have the multiple translations’; which necessarily includes specifying original languages and translated languages as claimed).

As per **claim 6**, the rejection is based on the same reason described for claim 6, because it also reads on the limitations of claim 6.

As per **claim 7** (depending on claim 6), Yamauchi further teaches “said output unit includes a printing device for printing the translated document data in a sheet” (Fig. 1, ‘plotter 11’).

As per **claims 8-9** (depending on claim 6), the rejection is based on the same reason described for claims 4-5, because the claims recite the same or similar limitations as claims 4-5 respectively.

As per **claim 10** (depending on claim 9), the rejection is based on the same reason described for claim 1, because the rejection for claim 1 covers the same or similar limitations as claim 10.

As per **claim 11**, the rejection is based on the same reason described for claim 6, because it also reads on the limitations of claim 11.

As per **claims 12-13** (depending on claim 11), the rejection is based on the same reason described for claims 7-8 respectively, because the claims recite the same or similar limitations as claims 7-8 respectively.

As per **claim 14**, the rejection is based on the same reason described for claim 6, because it also reads on the limitations of claim 6.

As per **claim 16** (depending on claim 14), the rejection is based on the same reason described for claim 4, because the claim recites the same or similar limitations as claim 4.

As per **claim 17**, the rejection is based on the same reason described for claim 1, because it also reads on the limitations of claim 17.

As per **claim 18** (depending on claim 17), the rejection is based on the same reason described for claim 1, because the rejection for claim 1 covers the same or similar limitations as claim 18.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi in view of Flores as applied to claim 1, and further in view of Miyahara et al. (6,314,213 B1) hereinafter referenced as Miyahara.

As per **claim 3** (depending on claim 1), Yamauchi in view of Flores does not explicitly teach “said output includes a sorter for sorting printed sheets by the group”. However, this feature is well known in the art as evidenced by Miyahara who teaches using ‘a sorter 22’ for discharging ‘paper sheet’ (Fig.2) (col. 7, lines 28-29) and ‘a soft key which is used to sort, staple/sort’) (col. 8, line 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamauchi in view of Flores by providing a sorter and/or related sorting functionality, as taught by Miyahara, for the purpose of implementing user preferred function, like sorting the resultant sheets (Miyahara: col. 8, lines 4-13).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

Art Unit: 2626

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Mail Stop _____
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to: 571-273-8300, (for formal communications intended for entry)

Or: 571-273-8300, (for informal or draft communications, and please label "PROPOSED" or "DRAFT")

If no Mail Stop is indicated below, the line beginning Mail Stop should be omitted from the address.

Effective January 14, 2005, except correspondence for Maintenance Fee payments, Deposit Account Replenishments (see 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(e)), please address correspondence to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

U.S. Patent and Trademark Office
Customer Window, Mail Stop _____
Randolph Building
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to QI HAN whose telephone number is (571)272-7604. The examiner can normally be reached on M-TH:9:00-17:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (571)-272-7602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

QH/qh
August 12, 2008

/David R Hudspeth/
Supervisory Patent Examiner, Art Unit 2626